APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
LEE, PHILIP C

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/771,158	COPP ET AL.
	Examiner	Art Unit	
	Philip C Lee	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 July 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>14-32</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>14-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.   This action is responsive to the amendment and remarks filed on July 06, 2004.

2.   Claims 14-32 are presented for examination.

3.   The text of those sections of Title 35, U.S. code not included in this office action can be

found in a prior office action.

Claim Rejections – 35 USC 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5.   The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

6.   Claims 14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Simpson et

al, U.S. Patent 6,559,965 (hereinafter Simpson).

7.   As per claims 14, Simpson taught the invention as claimed for a client to discover a

peripheral address, by way of a peripheral server (col. 8, lines 56-62), the method comprising:

        receiving a first message at the peripheral server, wherein the first message contains an

        address of the client (col. 4, lines 23-44); and

        receiving at the client a second message containing the peripheral address (col. 4, lines

        60-62), wherein the first message is formatted as a print job, the print job including no

        content resulting in a printed output (col. 5, line 22- col. 6, line 11).

8.   As per claim 16, Simpson taught the invention as claimed comprising:

        a client computer (122, fig. 2A)

        a peripheral server, connected to the client computer (124, fig. 2A), wherein the

peripheral server receives a first message from the client computer, the first message containing

an address of the client computer (col. 4, lines 23-44); and

        a peripheral, connected to the peripheral server, wherein the peripheral receives the first

message from the peripheral server and notifies the client computer of the peripheral's address

(col. 4, lines 23-62), wherein:

        the first message is formatted as a print job, the print job including no content resulting in

a printed output (col. 5, line 30-col. 6, line 11);

        the peripheral includes at least one non-printer function (col. 5, lines 7-21); and

the client computer is configured to access the at least one non-printer function of the

peripheral using the peripheral's address and without using the peripheral server (col. 5, lines 7-

21)

Claim Rejections – 35 USC 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson in

view of Manglapus et al, U.S. Patent 6,219,151 (hereinafter Manglapus).

11.   Manglapus was cited in the last office action.

12.   As per claim 17, Simpson did not teach wherein the interface generates a message to the

client computer. Manglapus taught wherein the second message is generated by peripheral with

a built-in network interface (fig. 3; col. 5, lines 33-37; col. 10, lines 59-62).

13.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson and Manglapus because Manglapus's

system generating message with a network interface would increase the flexibility of Simpson's

system by allowing the peripheral to connect to the network with different configuration.

14.   As per claim 18, Simpson taught the invention as claimed in claim 16 above. Simpson

did not specifically detailing a print queue. Manglapus taught a print server comprising a print

queue (col. 1, lines 25-31; col. 4, lines 30-31, 42-46).

15.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson and Manglapus because Manglapus's

system of the peripheral server including a print queue would increase the efficiency of

Simpson's system by allowing print jobs to be queue in the print server to avoid overloading the

printer.

16.   Claims 19-21, 23-24, 27-29 and 32 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Simpson in view of Bacher et al, U.S. Patent 6,728,012 (hereinafter Bacher).

17.   Bacher was cited in the last office action.

18.   As per claims 19 and 20, Simpson taught the invention as claimed in claim 16 above.

Simpson did not teach a multi-function peripheral. Bacher taught that the peripheral is a multi-

function peripheral (Abstract; col. 2, lines 45-54).

19.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson and Bacher because Bacher's multi-

function peripheral would increase the field of use in Simpson's system.

20.   As per claim 21, Simpson taught the invention as claimed comprising:

        sending a first message from a client to a peripheral server by way of a network, the first

        message including a network address of the client (col. 4, lines 23-44);

        sending the first message from the peripheral server to a peripheral by way of the

        network (col. 4, lines 23-44);

        sending a second message from the peripheral to the client by way of the network, the

        second message including a network address of the peripheral (col. 4, lines 45-62); and

        accessing a non-printer function of the peripheral by way of the network using the client

        and the network address of the peripheral and with using the peripheral server (col. 5,

        lines 7-21).

21.   Simpson did not teach a multi-function peripheral. Bacher taught that the peripheral is a

multi-function peripheral (Abstract; col. 2, lines 45-54).

22.   It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Simpson and Bacher because Bacher's multi-function peripheral would increase the field of use in Simpson's system.

23.   As per claim 23, Simpson and Bacher taught the invention substantially as claimed in claim 21 above. Simpson further taught wherein the first message is a print job (col. 1, lines 25-31).

24.   As per claim 24, Simpson and Bacher taught the invention substantially as claimed in claim 23 above. Simpson further taught wherein the print job includes no content resulting in a printed output (col. 5, lines 22-33).

25.   As per claims 27 and 32, Simpson and Bacher taught the invention substantially as claimed in claim 21 above. Bacher further taught wherein the non-printer function of the multifunction peripheral is a scanning function, a facsimile function, or a copier function (Abstract; col. 2, lines 45-54).

26.   As per claim 28, Simpson and Bacher taught the invention substantially as claimed in claim 21 above. Simpson further taught wherein the second message is formatted as a UDP datagram (col. 6, lines 12-17).

27.   As per claim 29, Simpson and Bacher taught the invention substantially as claimed in

claim 21 above. Simpson further taught wherein the second message is generated directly by the

multifunction peripheral (col. 4, lines 58-62).

28.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson and

Manglapus in view of Bacher.

29.   As per claim 15, Simpson taught the invention as claimed in claim 14 above. Simpson

did not teach spooling the first message to the peripheral from the peripheral server. Manglapus

taught wherein the peripheral is a printer, and the peripheral server is a print server comprising a

print queue, and the first message is spooled to the peripheral from the peripheral server by way

of the print queue (col. 1, lines 25-31; col. 4, lines 30-31, 42-46).

30.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson and Manglapus because Manglapus's

system of spooling the first message to the peripheral from the peripheral server would increase

the efficiency of Simpson's system by allowing print jobs to be queue in the print server to avoid

overloading the printer.

31.   Simpson and Manglapus did not teach wherein the peripheral is a multi-function printer.

Bacher taught wherein the peripheral is a multi-function peripheral (abstract; col. 2, lines 45-54).

32.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson, Manglapus and Bacher because

Bacher's multi-function peripheral would increase the field of use in Simpson's and Manglapus's

systems.

33.   Claims 22, 26 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Simpson and Bacher in view of Manglapus.

34.   As per claim 22, Simpson and Bacher taught the invention substantially as claimed in

claim 21 above. Although, Simpson and Bacher taught the multifunction peripheral includes a

printer function (see Bacher, col. 2, lines 45-54; abstract), however, Simpson and Bacher did not

teach a print queue. Manglapus taught the peripheral server includes a print queue (col. 1, lines

25-31; col. 4, lines 30-31, 42-46).

35.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson, Bacher and Manglapus because

Manglapus's system of the peripheral server including a print queue would increase the

efficiency of Simpson's and Bacher's systems by allowing print jobs to be queue in the print

server to avoid overloading the printer.

36.   As per claims 26 and 30, Simpson and Bacher taught the invention substantially as

claimed in claim 21. Simpson and Bacher did not specifically detailing the message is generated

by a separate interface device between the peripheral server and the peripheral. Manglapus

taught wherein the second message is generated by peripheral with a built-in network interface

(fig. 3; col. 5, lines 33-37; col. 10, lines 59-62).

37.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson, Bacher and Manglapus because

Manglapus's system generating message with a network interface would increase the flexibility

of Simpson's and Bacher's systems by allowing the peripheral to connect to the network with

different configuration.

38.   As per claim 31, Simpson and Bacher taught the invention substantially as claimed in

claim 21 above. Simpson and Bacher did not teach spooling the first message to the

multifunction peripheral. Manglapus taught a similar method comprising placing the first

message into a print queue of the peripheral server prior to sending the first message to the

multifunction peripheral (col. 1, lines 25-31; col. 4, lines 30-31, 42-46).

39.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson, Bacher and Manglapus because

Manglapus's system of spooling the first message to the peripheral from the peripheral server

would increase the efficiency of Simpson's and Bacher's systems by allowing print jobs to be

queue in the print server to avoid overloading the printer.

40.   Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson and

Bacher in view of Gunning et al, U.S. Patent 6,094,548 (hereinafter Gunning).

41.   Gunning was cited in the last office action.

42.   As per claim 25, Simpson and Bacher taught the invention substantially as claimed in

claim 23 above. Simpson and Bacher did not teach a PML object. Gunning taught wherein the

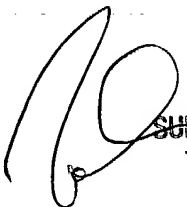print job contains a PML object (col. 3, lines 55-65; col. 4, lines 6-11).

43.   It would have been obvious to one having ordinary skill in the art at the time of the

invention was made to combine the teachings of Simpson, Bacher and Gunning because

Gunning's method of PML object would increase the efficiency of Simpson's and Bacher's

systems by allowing embedded command to be transmitted with the print job in a single

message.

44.   Simpson, Bacher and Gunning did not specifically detailing the type of PML. It would

have been obvious to one having ordinary skill in the art at the time of the invention was made to

include UI_SELECT_OPTION or other object as the PML object as the design choice of the

invention because by doing so would increase the field of use in their invention.

45.   Applicant's arguments with respect to claims 14-32, filed 07/06/04, have been fully

considered but are not deemed to be persuasive and are moot in view of the new grounds of

rejection.

46.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action

is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply

is filed within TWO MONTHS of the mailing date of this final action and the advisory action is

not mailed until after the end of the THREE MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX

MONTHS from the mailing date of this final action. Any inquiry concerning this

communication or earlier communications form the examiner should be directed to Philip Lee

whose telephone number is (703) 305-7721. Any inquiry of a general nature or relating to the

status of this application should be directed to the Group receptionist whose telephone number is

(703) 305-9600.

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Philip Lee